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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,586	03/09/2004	Christina Prowell	4962	1112

48226 7590 02/23/2007  
BASF CATALYSTS LLC  
101 WOOD AVENUE  
ISELIN, NJ 08830

EXAMINER
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SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/796,586

Applicant(s)

PROWELL ET AL.

Examiner

Sandra K. Poulos

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. All outstanding rejections and objections except for those described below are overcome by applicant's amendment filed 11/30/06.

Upon consideration of applicant's arguments, the rejections set forth in the action mailed 8/28/06 have been reconsidered and the following new grounds of rejection have been set forth below. Accordingly, the following action is **NON-FINAL**.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 1, 4-12, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornelius (US 4,677,141).

The discussion with respect to Cornelius in paragraph 4 of the Office action mailed 8/28/06 is incorporated herein by reference.

Cornelius discloses a method of improving the heat stability of silicone elastomers with pretreated white clay (abstract). The composition can be pigmented (abstract). Kaolin is particularly preferred because it is readily available in white form (col 4, lines 30-31). The clay in example 1 is calcined kaolin clay treated with approximately 1% of vinyl-tri(beta-methoxyethoxy)silane and has a particle size of 0.81 micrometers (col 7, lines 15-21). The amount of clay is from 1 to 150 parts by weight (col 2, lines 21-22). The silicone elastomer is heated to vulcanize (abstract), however

Art Unit: 1714

the time and temperature necessary to cause vulcanization are dependent on the vulcanization agent, the method of heating, the method of forming the composition into a shape, and the thickness of the part (col 6, lines 26-30). Cornelius discloses that the temperature that is appropriate for a given set of conditions is well known in the silicone elastomer art (col 6, lines 30-32).

Although Cornelius does not explicitly disclose the "greater than 1.0 wt%" of organosilane generally used to pretreat the kaolin clay, he discloses "approximately 1 percent by weight" is used. Therefore, since "approximately" inherently includes values slightly above and below 1 percent, Cornelius anticipates the currently claimed range, particularly at values just above 1.0 wt%.

3. Claim 1-3, 5-9 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (US 5,907,921).

Hill discloses a composition containing a silicone elastomer and aminofunctional siloxane in an amount of 0.10 to 10 wt% based on the silicone elastomer (abstract, col 11, lines 31-49). Kaolin clay is added to the composition (col 12, lines 25-35; example 14).

Thus Hill anticipates the cited claims.

4. Claims 1-3, 11, 16, 18-19, 21-23, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekutowski (US 4,740,538).

The discussion with respect to Cornelius in paragraph 3 of the Office action mailed 8/28/06 is incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 2-3, 13-14, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius et al (US 4,677,141).

The discussion with respect to Cornelius in paragraph 4 of the Office action mailed 8/28/06 is incorporated herein by reference.

***Response to Arguments***

6. Applicant's arguments filed 11/30/06 have been fully considered but they are not persuasive. In particular, applicant has argued that "approximately" 1 wt% is not the same as "greater than" 1 wt%. This is not convincing because "approximately" inherently includes values slightly above and below 1 percent, particularly at values just above 1.0 wt%.

Additionally, applicant argues that the examples compare 0.8 wt%, 1.0 wt%, and 1.24 wt% and that only a slight percentage increase produces unexpected results. The values in claims 2 and 3 are 1.1 wt% and 1.2 wt%, respectively. Given that applicant maintains that only a slight percentage increase produces unexpected results, the

Art Unit: 1714

examples are not convincing since there is no data for the amounts 1.1 wt% and 1.2 wt%, but instead only for 1.24 wt%, which is greater than those claimed points. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

Lastly, applicant argues that Sekutowski does not contain silicone. Sample 14 contains silicone oil, which is claimed in current claim 11 and thus anticipates the claims.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

Art Unit: 1714

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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